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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/654,795	09/03/2003	Richard J. Sacks	P1425	6963
24739	7590	11/03/2005	EXAMINER	
CENTRAL COAST PATENT AGENCY			DESAI, ANISH P	
PO BOX 187			ART UNIT	
AROMAS, CA 95004			PAPER NUMBER	
			1771	

DATE MAILED: 11/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/654,795

Applicant(s)

SACKS, RICHARD J.

Examiner

Anish Desai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,7,11 and 13-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,7,11 and 13-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 August 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 08/11/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. The drawings were received on 08/11/05 in response to the office action mailed on 05/20/05. These drawings are not acceptable for the following reasons. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Applicant's Amendments/Remarks

2. The applicant's amendments/remarks received on 08/11/05 to the claims in response to the office action mailed on 05/20/05 are carefully reviewed and considered. In view of the amendments, the art rejection has been modified and new ground of rejection is made in this office action. Applicant's cancellation of claims 6, 8-10, and 12 are entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 5, 15, and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter

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which applicant regards as the invention. Claim 5 recites needle-pointing. It is unclear as to what applicant means by needle-pointing. For the purpose of examination, the examiner is interpreting any conventional way of applying two layers using a needle as needle-pointing. The conventional way can include sewing two layers using a needle. Additionally, claim 5 recites the limitation "first layer", there is insufficient antecedent basis for this limitation in the claim. For the purpose of the examination, the examiner is interpreting the "first layer" as the claimed "bottom layer".

4. Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 15 recites the limitation "two layers of padding material", there is insufficient antecedent basis for this limitation in the claim.

Claim 17 contains the trademark/trade name Velcro. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe "closure" and, accordingly, the identification/description is indefinite. Additionally, claim 17 recites phrase "such as", the phrase "such as" renders the claim indefinite because it is unclear

whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-5, 7, 11, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ricken (US Patent 4,974,397) in view of Bryant et al. (US Patent 5,366,801) and Schortmann (US Patent 4,499,139).
6. Ricken teaches an anti-stress saddle pad formed of multiple layers of material (see Abstract). The saddle pad contains layers from top to bottom as follows: (a) a sheet of felt, (b) a sheet of visco-elastic polymer, (c) a sheet of open-celled polyurethane foam, and (d) a sheet of felt. A sheet of vinyl covers the top surface of the saddle pad (Column 2, lines 59-66). According to Ricken, the visco-elastic polymer and the open-celled polyurethane foam absorb shocks and vibrations (Column 1, lines 51-59). A felt material can function as padding. A bottom sheet of felt of Ricken reads on applicant's claimed bottom layer of natural padding material. The open-celled polyurethane foam of Ricken corresponds to the applicant's third layer of shock absorbing material. The vinyl sheet of Ricken reads on applicant's top layer of high friction non-skid material. Although the invention of Ricken does not explicitly teach that

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the vinyl sheet functions as a high friction non-skid surface, it is known in the art that vinyl is durable and provides sufficient friction and can function as non-skid material (see Green, US Patent 5,575,139, Column 3, lines 1-8). Additionally, note that with respect to the recitation "adjacent", the examiner is interpreting that the term "adjacent" does not necessarily mean that the two layers are in contact with each other. With respect to claims 2 and 4, Ricken does not explicitly teach the woven and nonwoven padding material and sheep's wool, however the felt material of Ricken can be woven or nonwoven and can be made of wool (See Complete Textile Glossary, Celanese® Acetate). With respect to claim 11, the material of the vinyl sheet of Ricken can function as durable material and thus considered to be wear resistant.

7. Regarding claim 1, Ricken does not specifically teach the saddle pad comprising a phase change material joined to the padding material on the side opposite the side contacting the animal's flesh. Bryant et al., however, disclose a fabric coated with a layer of phase change material to regulate the temperature and keep the wearer cool and comfortable (Column 4, lines 9-14, Column 5, lines 25-28). The fabric of Bryant et al. can be woven, knitted or nonwoven (Column 4, lines 25-26). Note that Bryant et al. is working towards obtaining a fabric coated with the phase change material in order to regulate the temperature. The applicant is also working to provide a product with sophisticated temperature management (see Specification Page 3).

8. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to apply the coating layer of Bryant et al. comprising the phase change material to the felt sheet of Ricken on the side opposite the side

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contacting the horse's flesh, motivated by the desire to keep the horse cool and comfortable.

9. Regarding claim 1, Ricken is silent as to teaching an anti-bacterial batting material above and adjacent to the padding material. Schortmann teaches a micro-sized fabric. The fabric of Schortmann establishes bacterial barrier and preserves the air permeability (Column 2, lines 41-47). Schortmann teaches that the micro-sized pores allow greater air permeability, thus allowing the body heat to escape (Column 5, lines 11-29). Thus, Schortmann is working towards obtaining a fabric with a better temperature control. Note that the applicant is also working to provide a product with sophisticated temperature management (see Specification Page 3).

10. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to apply the micro-sized fabric of Schortmann with greater air permeability and used it as an anti-bacterial layer in the invention of Ricken, motivated by the desire to provide the saddle pad with anti-bacterial resistance and greater air permeability and thus protecting the horse from disease and keeping cool.

11. With respect to claim 3, Ricken is silent with respect to teaching the padding material is an open-celled or closed-celled material and PCM is coated on individual cell of the foam material. Bryant et al. teach that the coating is fabricated by adding the phase change materials to the polymeric binder (liquid, solution or dispersion), compounding, curing, crosslinking or foaming to form a flexible layer on a substrate such as a fabric according to conventional coating methods (Column 4, lines 9-14). The polymeric binder can be of polyurethane (Column 3, line 29). Thus, the foamed

polyurethane binder is considered to be foam and it can be made of open or closed cell.

Note that the polyurethane foam can necessarily function as a padding material.

12. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the foamed polyurethane binder mixed with the phase change material of Bryant et al. and used it in the invention of Ricken as a padding material, motivated by the desire to keep the horse cool and comfortable.

13. Regarding claim 4, Ricken is silent with respect to teaching PCM is a non-woven PCM-coated sheet material applied to the wool on the side away from the animal's flesh. The invention of Bryant et al. is previously disclosed.

14. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to apply the non-woven fabric coated with the phase change material of Bryant et al. to the to the sheet of felt of Ricken on the side opposite the side contacting the horse's flesh, motivated by the desire to keep the horse cool and comfortable.

15. Regarding claim 5, all of the above-applied references are silent with respect to teaching needle-pointing as claimed. However, claim 5 is a product by process claim and product by process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. "Even though product by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product by process claim is the same as or obvious

from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985).

16. Once the Examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289, 292 (Fed. Cir. 1983). In the instant case, the composite structure of the applicant is similar to the structure of Ricken in view of Bryant et al. and Schortmann. Ricken in view of Bryant et al. and Schortmann teach a layer of felt, a layer of micro-sized fabric, a layer of open celled polyurethane foam, a layer of vinyl sheet, and a phase change material coated to the felt layer.

17. The use of 35 USC 102/103 rejections for product by process claim has been approved by the courts. "[T]he lack of physical description in a product by process claim makes determination of the patentability of the claim more difficult, since in spite of the fact that the claim may recite only process limitations, it is the patentability of the product claimed and not of the recited process steps which must be established. We are therefore of the opinion that when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product by process claim, a rejection based alternatively on either section 102 or section 103 of the statute is eminently fair and acceptable. As a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put

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before it and then obtain prior art products and make physical comparisons therewith."

In re Brown, 173 USPQ 685, 688 (CCPA 1972).

18. Regarding claim 7, Ricken is silent with respect to teaching the phase change material with phase change temperature of about 95°F. Bryant et al. disclose the n-eicosane compound (Column 3, line 61) as the phase change material with the phase change temperature of 36.5°C which equates to the claimed phase change temperature of 95°F (35°C).

19. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to apply the coating layer of Bryant et al. comprising the phase change material n-eicosane with the phase change temperature of 36.5°C to the felt sheet of Ricken, motivated by the desire to keep the horse cool and comfortable

20. Regarding claim 14, Ricken teaches claimed invention except for the weight of the shock absorbing material. The weight of the shock absorbing material affects the strength & durability of the material. For example, greater the weight of the shock absorbing material, the strength and the durability also increases. It would have been obvious to one having ordinary skill in the art at the time the invention was made to choose the weight of the shock absorbing material to be 7 lb, since it has been held that discovering an optimum value of a result effective variable involves routine skill in the art. *In re Boesch*, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980). Recall that the polyurethane foam of Ricken functions as a shock absorbing material.

21. Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ricken (US Patent 4,974,397) in view of Bryant et al. (US Patent 5,366,801) and

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Schortmann (US Patent 4,499,139) as applied above to the claim 1, and further in view of Woods (US Patent 5,802,823).

22. Ricken is silent with respect to teaching the pocket between the two layers of padding material, pocket comprising a closure for retaining the shock-absorbing material in the pocket, and closure comprises one of a zipper, a set of buttons and button-holes, a set of eyelets with laces, or a closure tape such as Velcro®.

23. Woods teaches a shock absorbing panel assembly for saddles. The panel assembly comprises shock absorbing panels and pockets for fitting them in (Column 1 lines 66, Column 2, lines 1-5). The pocket has an opening, which can be releasably closed by means of hook and loop type material (Column 3, lines 19-22). The opening is considered as closure as claimed in the present invention.

24. Therefore it would have been obvious to one having ordinary a skilled in the art at the time the invention was made to use a pocket with an opening which can be closed by means of hook and loop type material disclosed in the invention of Woods and used it to enclosed the shock absorbing open-celled polyurethane foam of Ricken, motivated by the desire to effectively secure the shock absorbing polyurethane foam of Ricken.

25. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ricken (US Patent 4,974,397) in view of Bryant et al. (US Patent 5,366,801) and Schortmann (US Patent 4,499,139) as applied above to the claim 1, and further in view of Widdemer (US Patent Application Publication 2002/0035755).

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26. Ricken is silent with respect to teaching that at least one layer comprises fiber based on rare earth elements, an optically responsive to both wavelengths of ambient light and energy produced by an animal's body, to interact with the animal in a manner to increase oxygenated blood flow through cell structure of the flesh.

27. Widdemer teaches leather made beneficially interactive with the human body through the insertion of rare earth elements into its fiber matrix for use in garments, footwear, gloves or upholstery. These rare earth elements in sufficient amount will reflect and amplify infrared radiation from environment and human body such that it causes beneficial effects (e.g. increase in blood flow) (see Abstract). In addition, a layer of phase change material can be added to the surface of the leather to provide a temperature stabilizing material (see Abstract). Note that, Widdemer is working towards obtaining a leather fabric with a better temperature stabilization. Note that the applicant is also is also working to provide a product with sophisticated temperature management by absorbing the heat generated by the body of the horse and/or rider (see Specification Page 3).

28. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made use rare earth elements disclosed in the invention of Widdemer and used it in one of the layer (e.g. felt) disclosed in the invention of Ricken. One would be motivated to do this in order to provide increased blood flow, simulating cellular activities and general well being.

Response to Applicant's Arguments

29. With regards to the applicant's argument on page 9, "The examiner provides other various piece of art in order to teach the other layers of applicant's composite material. Applicant argues that merely providing references providing the existence of certain material is not enough. There must be some motivation or suggestion in the art to make the inventive combination and application claimed by the inventor of the present invention." The examiner disagrees. In response, the examiner would like to guide applicant's attention to the office action mailed on 05/20/05 where examiner has provided motivation to combine each reference. Also note that, the applicant has generally asserted a lack of motivation but has not pointed to specific errors in making the combination of references and that since the motivation is clearly set forth in the previous action and applicant has not specifically traversed the motivations set forth in the previous office action, hence the applicant's arguments are moot.

30. With respect to the applicant's argument on Page 9 that "in order to establish prima facie case of obviousness three basic criteria must be met...". The examiner acknowledges the applicant's statement and wishes to point out that Under Section 103, the obviousness of an invention cannot be established by combining the teachings of the prior art references absent some teaching, suggestion or incentive supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). **This does not mean that the cited prior art references must specifically suggest making the combination.** *B.F. Goodrich Co. v. M Aircraft Braking Systems Corp.*, 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed.

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Cir. 1996); *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988)).

Rather, the test for obviousness is what the combined teachings of the prior art references would have suggested to those of ordinary skill in the art. *In re Young*, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991); *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). **This test requires us to take into account not only the specific teachings of the prior art references, but also any inferences which one skilled in the art would reasonably be expected to draw therefrom.** *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

31. With respect to the applicant's argument on Page 9 that "Ricken makes no suggestion nor provide motive for stabilizing temperature in saddle pad....Further the other references provided by the provided by the Examiner make no suggestion to use the material taught in the application of present invention." The examiner disagrees. In response, the examiner wishes to point out that at Column 1, line 68 and Column 2, lines 1-2, Ricken teaches that the polyurethane foam softens with increased humidity and transfers moisture away from the body (i.e. horse body) to aid in cooling it (Column 1, line 68, Column 2, lines 1-2). Hence, Ricken recognizes the regulation of temperature in the saddle pad as important function for providing the comfort to the horse. Bryant et al. uses the phase change material to coat the fabric and uses their invention to protect individual and machinery from cold or hot. Contrary to the applicant's argument, Bryant et al. do not exclude any animals from being part of an individual and provide a way of regulating the temperature by using the phase change material and keeping the individual protected from hot and cold.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anish Desai whose telephone number is 571-272-6467. The examiner can normally be reached on Monday-Friday, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

APD

Hai V
HAIVO
PRIMARY EXAMINER